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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,298	07/15/2003	Dennis L. Fowler	5199/98US	7035
29858	7590	09/07/2005	EXAMINER	
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/620,298	FOWLER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Matthew J. Kasztejna	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 23-28 is/are withdrawn from consideration.
- 5) Claim(s) 22 is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) 16-19 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/26/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-22, in the reply filed on August 8, 2005 is acknowledged. Claims 23-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without traverse** in the reply filed on August 8, 2005.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

The drawings are objected to because of the insufficient quality of Figures 8 and 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the driving device 202 and controller 204 in Figure7, as well as the lack of any reference numbers in Figures 8 and 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "at least one actuating element" in line 2 of claim 14. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, and 6-8 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,719,684 to Kim et al.

**In regards to claim 1,** Kim et al. disclose a device insertable into a structure having a lumen comprising: a first housing 10; at least one functional element 11 connected to the first housing, for use during a minimal access procedure; and a securing element 15a associated with the insertable device for removably securing the insertable device within the structure (see Fig 1a).

**In regards to claim 2,** Kim et al. disclose a device insertable into a structure having a lumen, wherein the at least one functional element is movably connected to the first housing, the device further comprising at least one actuating element connected to the first housing and the functional element, for moving the functional element in relation to the first housing in at least one degree of freedom (see Col. 3, Lines 33-35).

**In regards to claims 6-8,** Kim et al. disclose a device insertable into a structure having a lumen, wherein the functional element is a camera element 11 (see Col. 3, Lines 6-35).

Claims 1-5, 9 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,540,693 to Burbank et al.

**In regards to claim 1,** Burbank et al. disclose a device insertable into a structure having a lumen comprising: a first housing 80; at least one functional element 86 connected to the first housing, for use during a minimal access procedure; and a securing element 100 associated with the insertable device for removably securing the insertable device within the structure (see Fig. 15 and Col. 9, Lines 53-67).

**In regards to claim 2,** Burbank et al. disclose a device insertable into a structure having a lumen, wherein the at least one functional element is movably connected to the first housing, the device further comprising at least one actuating element connected to the first housing and the functional element, for moving the functional element in relation to the first housing in at least one degree of freedom (see Col. 8, Lines 45-67).

**In regards to claims 3-5,** Burbank et al. disclose a device insertable into a structure having a lumen, wherein the securing element comprises a needle protruding from the insertable device essentially inline with an elongated axis of the device (see Fig. 15). Furthermore, Burbank et al. teach of a securing element that may comprise an adhesive (see Col. 3, Lines 34-39).

**In regards to claims 9 and 11,** Burbank et al. disclose a device insertable into a structure having a lumen, wherein the at least one functional element is movably connected to the first housing, the device further comprising at least one actuating element connected to the first housing and the functional element, for moving the functional element in relation to the first housing in a degree of freedom selected from a group consisting of: a first degree of rotational freedom essentially orthogonal to an

elongated axis of the device; a second degree of rotational freedom essentially inline with the elongated axis; and a third degree of translation freedom essentially inline with the elongated axis (see Col. 8, Lines 45-67).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,719,684 to Kim et al. in view of U.S. Patent No. 6,648,817 to Schara et al.

**In regards to claims 10 and 21,** Kim et al. disclose a device insertable into a structure having a lumen, but are silent with respect to the device comprising at least one actuating element connected to the first housing and the functional element, for moving the camera element in relation to the first housing in at least one degree of freedom selected from a group consisting of: a first degree of rotational freedom essentially orthogonal to an elongated axis of the device; a second degree of rotational freedom essentially inline with the elongated axis; and a third degree of translation freedom essentially inline with the elongated axis (see Fig 15 and Col. 8, Lines 46-67). However, Kim et al. teach that it is desirable to have a camera unit 11 with a function to change the imaging direction, and it is inherently known in the art, that a desirable feature of endoscopic systems is to be able to view in all directions (see Col. 3, Lines

34-35). Schara et al. teach of an analogous endoscopic device wherein a user is provided with a pivotal optical component, which provides an increased or unlimited scanning range (see Col. 2, Lines 1-27). It would have been obvious to one skilled in the art at the time the invention was made to include a means for changing the imaging direction of the camera unit of Kim et al. in order to provide the user increased viewing freedom as taught by Schara et al. and is well known in the art.

Claims 12-15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,540,693 to Burbank et al. in view of U.S. Patent No. 6,454,727 to Burbank et al.

**In regards to claim 12-13,** Burbank et al. disclose a device insertable into a structure having a lumen, but are silent with respect to wherein the actuating element is a motor for producing movement in a adirection essentially orthogonal to the elongated axis. Burbank et al. ('727) teach of an analogous device having a motor to rotate a cutting wire. It is well known in the art to use motors in various medical apparatus to drive actuating members. It therefore would have been obvious to one skilled in the art at the time the invention was made to include a motor to drive the actuating element in the apparatus of Burbank et al. ('693) to provide a more efficient and reliable actuating element as taught by Burbank et al. and is well known in the art.

**In regards to claims 14-15 and 20,** Burbank et al. disclose a device insertable into a structure having a lumen, but are silent with respect to a second housing a second housing rotatably attached to the first housing and wherein at least one actuating element is further connected to the second housing for moving the functional

element in relation to the first housing in a second degree of rotational freedom essentially inline with an elongated axis of the device by rotating the first housing in relation to the second housing. Burbank et al. ('727) teach of an analogous device having a first motor which is used to rotate an outer cannula (see Figs. 1 and 4). Furthremore, Burbank et al. teach of a second motor which moves the cutting wire longitudinally (see Col. 5, Lines 30-67). It would have been obvious to one skilled in the art at the time the invention was made to include a rotatable second housing in the apparatus of Burbank et al. ('693) in order to provide better protection to the functional elements of the deivce as it is being inserted and postioned within the patient's body as taught by Burbank et al.

***Allowable Subject Matter***

Claims 16-19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 22 is allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK  
MK  
8/31/05



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PRIMARY EXAMINER